

REMARKS

In response to an Advisory Action dated May 19, 2006 (following a Final Official Action dated February 24, 2006), Applicant respectfully submits the following remarks. This application contains claims 1, 4-19 and 22-37, all of which were rejected in the present Official Action. Reconsideration is respectfully requested in view of the remarks that follow.

Applicant thanks Examiners Stork and Paula for the courtesy of a personal interview with Applicant's representative, Sanford T. Colb (Reg. No. 26,856), held in the USPTO on June 15, 2006. At the interview, Mr. Colb explained the distinction of claims 1, 19 and 35 over the cited art. The Examiners agreed that these claims appear to distinguish the invention over the art of record. Mr. Colb also argued that the Rule 131 Declaration filed by Applicant provided sufficient evidence of prior conception and diligence in constructive reduction to practice in order to swear behind Bruce et al. (U.S. Patent 6,741,724) and thus to overcome the rejection of independent claims 12, 30 and 37. In consultation with Examiner Pinchus Laufer, the Examiners informed Mr. Colb that additional documentary evidence of diligence in reduction to practice (items 5-8 in the Declaration that was submitted previously) would be required in order to overcome Bruce. Applicant accordingly submits herewith a revised declaration with the required evidence.

Claims 1, 5-11, 19, 23-29, 35 and 36 were rejected under 35 U.S.C. 103(a) over Lorie (U.S. Patent 5,933,531) in view of Jansen et al. (U.S. Patent 6,243,450). Applicant respectfully traverses this rejection. As agreement was reached in the interview that claims 1, 19 and 35 do distinguish over the art of record, Applicant will only briefly summarize here the remarks made in the previous response (filed April 24, 2006) to the Final Official Action. The full remarks are incorporated herein by reference.

Claim 1 recites a method for document processing, in which images of document fields are received over a network from a client and are processed to code information contained in the fields. Directory look-up is used to check whether the information is coded correctly. The checked, coded information is returned to the client over the network. Payment is received from the client according to the number of fields that were processed, based upon a price per field processed.

In rejecting claim 1, the Examiner asserted that Lorie discloses the steps of receiving images of fields from a client via a computer network and returning the checked coded information over the network to the client. In the previous response, Applicant pointed out that Lorie makes no mention of any sort of client, nor does he mention or even suggest that images might be sent over a computer network and coded information returned over the network. In the Advisory Action, the Examiner responded that “Lorie teaches receiving images,” but this point was not in dispute. The Examiner then reiterated his reference to the boilerplate recitation in Lorie (col. 9, lines 1-9) in which servers are mentioned, and asserted that “a server is well known in the art to serve content to another device (i.e. client).” Be that as it may, the mere mention of a server in this general context could not possibly have suggested the specific steps of receiving images of fields from a client via a computer network and returning checked coded information over the network to the client, as recited in claim 1.

In the Final Official Action, the Examiner maintained that Jansen discloses receiving payment for a service based upon a price per unit of service. In the previous response, Applicant pointed out that Jansen charges for service using a conventional model of price per unit time, rather than charging for processing fields containing information on the basis of a price per field, as required by claim 1. The only teaching of record that might point in the direction of charging for processing based on a price per field processed is impermissible hindsight from the present patent application. The Examiner did not address this point in the Advisory Action.

Thus, to summarize, the references cited by the Examiner fail to teach or suggest not just one, but several distinguishing elements of claims 1, 19 and 35. Therefore, Applicant believes these claims to be patentable over the cited art, as are dependent claims 5-11, 23-29 and 36.

Claims 4 and 22 were rejected under 35 U.S.C. 103(a) over Lorie in view of Jansen and further in view of Bruce et al. (U.S. Patent 6,741,724). Applicant respectfully traverses this rejection on the basis of both the patentability of amended claims 1 and 19 and the disqualification of Bruce as prior art against the present patent application, as explained below.

Claims 12-16, 18, 30-34 and 37 were rejected under 35 U.S.C. 103(a) over Lorie in view of Bruce, while claim 17 was rejected over Lorie in view of Bruce and further in view of Jansen. Applicant respectfully traverses this rejection, on the grounds that the invention recited in

independent claims 12, 30 and 37 was conceived prior to the filing date of Bruce (March 24, 2000), and that Applicant diligently pursued the constructive reduction to practice of the present invention from March 24, 2000, up to the filing date of the present patent application.

As agreed in the interview, Applicant submits herewith a new Declaration under 37 CFR 1.131, proving conception of the invention prior to March 24, 2000, and providing detailed, documentary evidence of diligence in reduction to practice during the period between March 24 and July 14, 2000, when the present patent application was filed. Applicant believes that this additional evidence is more than sufficient to meet the evidentiary requirements that were set forth in the interview by Examiner Laufer.

In the Final Official Action, the Examiner held that Applicant's previous Declaration was also ineffective in proving conception of the invention because "not all the limitations of the claims [presumably the limitations of claim 12] are disclosed in Appendix A." The Examiner appeared to take the position that because the Disclosure does not provide literal support for all the words used in the claim, it does not prove conception of the claimed invention. As pointed out in Applicant's previous response, however, MPEP 715.07(I) makes clear that such literal support is not required, and a person of ordinary skill in the art, upon reading Appendix A, would have readily understood it to disclose all the elements of claims 12, 30 and 37. On this issue, too, the detailed arguments set forth in Applicant's previous response are incorporated herein by reference. The Examiner did not address these arguments in the Advisory Action, other than simply to reiterate that "the examiner has already advised the applicant that the current declaration fails to provide sufficient detail to establish conception prior to 24 March 2000," without further explanation.

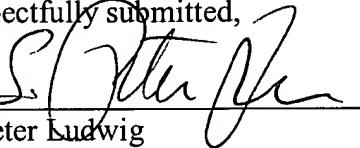
Thus, Applicant respectfully submits that the new Declaration and supporting evidence submitted herewith are sufficient to prove conception of the invention recited in claims 12, 30 and 37 prior to March 24, 2000, and diligence in constructive reduction to practice between that date and the filing date of the present patent application, July 14, 2000. Therefore, Bruce may not be considered prior art against the present patent application, and the rejection of claims 12-18, 30-34 and 37 should be withdrawn.

Applicant believes the remarks presented hereinabove to be fully responsive to all of the grounds of rejection raised by the Examiner. In view of these remarks, Applicant

respectfully submits that all of the claims in the present application are in order for allowance. Notice to this effect is hereby requested.

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Respectfully submitted,

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